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EXAMINER

STEELMAN, MARY J

ART UNIT	PAPER NUMBER
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2191

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/699,566

Applicant(s)

DUTTA, PIJUSH

Examiner

Mary J. Steelman

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to Amendments and Remarks received 01/05/2007. Per Applicant's request claims 6-13 have been added. Claims 1-13 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It appears to Examiner that claim 1 is a method for grouping and identifying features. Where the result is what has been determined, calculated, etc. without using what has been determined calculated, etc in a disclosed practical application or at least making what has been determined, calculated, etc. available for use through some form of conveyance, such as a display, print, sound, transmission, etc., or at least temporary storage somewhere, the current guidelines is that a tangible result has not been achieved. These claims appear to be non-statutory for failing to produce a tangible result which enables any usefulness of having made the determination to be realized.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The term 'database' constitutes new matter.

Response to Arguments

5. Applicant's arguments with respect to claims have been considered but are moot in view of the new grounds of rejection.

(A) Applicant has argued the 35 USC 101 rejection. The rejection provided is not based on the technological art test and so Lundgren does not apply. The test applied is based on producing a physical transformation or a useful, concrete and tangible result. Since the result of the identifying is not stored or used by another process to produce a result. Examiner maintains the rejection of claims 1-6.

(B) Applicant argues that Carpenter does not relate to extracting business logic from computer code having a plurality of statements (page 8, 2nd paragraph)

Examiner's Response: Examiner disagrees. Carpenter: Col. 8: 65 – col. 9: 11, "The AMR Server of the present invention advantageously offers a large scale system solution to address the management of metering data and the administration of the system that perform the management...to accommodate the variety of legacy systems and platforms existing...to accommodate customer to customer differences in requirements, business logic and regulatory requirements."

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(C) Applicant argues, in substance, Carpenter does not disclose, expressly or inherently, examining statements in computer code to identify a plurality of conditional statements and a plurality of action statements, tagging the plurality of conditional statements and the plurality of action statements, generating actions sets based on the conditional statements, or identifying associated sets of action statements.

Examiner's Response:

Examiner disagrees. Col. 20: 50-col. 23: 41, Activity ManagementSubsystem 146, Activity Plan Builder 146d. See FIG. 4 and related text col. 28: 6 – col. 31: 33, Mapping Subsystem 140 and Canonical Mapper 140a, used to translate files. “Canon is a template that describes a general format for a domain of information that is to be converted.” Col. 30: 33-48, “Building a map entails selecting each component of the input file and defining its function (identifying & tagging) in terms of the Cannon being used. Attributes about certain Canonical Elements are defined...group elements may have modifiers defined for them. A modifier is a conditional statements that further defines its function...” Activity Plans (col. 20: 54) are grouped tasks.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1-4 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,199,068 B1 to Carpenter.

Per claims 1, 6, and 10:

A method for extracting business logic from computer code having a plurality of statements, the method comprising:

Carpenter disclosed extracting business logic at col. 11, line 1. Col. 10: 61, "abstract business logic" Col. 19: 61, "business logic encapsulated in each Activity Plan"

-examining the plurality of statements to identify a plurality of conditional statements and a plurality of action statements;

Carpenter disclosed (col. 6, line 12), "the input map defines a function of each component of the input file in terms of the canon being used, and the output map defines a function of each component of the output file in terms of the canon being used. The input and output maps further comprise attributes about canonical elements, modifiers for canonical elements having specific values, **conditional statements** that further define a function of the canonical elements having specific values, tokens that specify a format of the values in a particular map, and **actions** that specify the format of certain parts of a file." (emphasis added)

Carpenter disclosed examining a plurality of action statements into Activity Plans (col. 11, lines 1-9).

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- tagging the plurality of conditional statements and the plurality of action statements, wherein each conditional statement has an associated tag and each action statement has an associated tag;
- grouping the plurality of conditional statements and the plurality of action statements;
- generating a plurality of action sets based on the plurality of conditional statements, wherein each of the plurality of action sets includes an associated set of action statements;
- for each action set, identifying the associated set of action statements from the grouped plurality of action statements.

Carpenter disclosed (col. 5, line 39) a canonical mapper to translate an input file from an input domain to an output domain. Col. 5, lines 56-65, “the canonical mapper utilizes the input map and the output map to build a scanner/parser (grouping) for the input file domain...re-interpreting (translating) a corresponding element in the canonical list such the corresponding element conforms to the output domain (grouping).” Col. 6, line 67, “the canon comprises an abstract template that describes a structure of the domain of information...each canonical element is an abstraction, and each division or part of each of the element is subsequently defined (tagged) in terms of less abstract element.” Col. 6, line 12, “the input map defines a function of each component of the input file in terms of the canon being used, and the output map defines a function of each component of the output file in terms of the canon being used. The input and output maps further comprise attributes about canonical elements, modifiers for canonical elements having specific values, conditional statements that further define a function of the canonical elements having specific values, tokens that specify a format of the values in a particular map, and actions that specify the format of certain parts of a file. (generating a plurality of action sets based on the plurality of conditional statements)”

Col. 2: 50, "Activity Management Subsystem 146 The services are grouped and serialized to perform business operations. The grouping and control of the service execution (to accomplish a specific high level business task) is the job of the Activity Plan object." Activity Plan instances are named (tagged), for example, by the business unit of work they accomplish and contain an ordered list of tasks (action statements) that interact with individual services in the system. Task instances are named for the service they invoke and know their prerequisites (conditional statements) and possible alternate cases (alternate action sets) in the event of service failure.

Activity Plans are further addressed at col. 19: 33+. Col. 19:38, "Activity Plans may be thought of as a list of tasks or operations that are performed to complete a business unit of work. The tasks....invoke a system service for its task and have information delivered and returned." Col. 20: 51-63, "In order for Activity Plans to flexibly control system actions, the system is modeled and implemented as a cooperating set of medium to low level services. The services are grouped and serialized to perform business operations. Activity Plan (action set) instances are named...and contain an ordered list of tasks (action statements)...Task instances are named...and know their prerequisites (conditional statements) and possible alternate cases in the event of service failure.

Col. 21: 7-56, "The Activity Plan Builder 146d is provided...Activity Plans are the objects that manage a set of tasks to perform a unit of business work...Activity Plan object itself is simply a

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manager and container for the tasks that get the work done. An ordered collection of tasks are constructed and assigned to the Activity Plan...”

Per claim 2:

-each conditional statement is uniquely identified by its associated tag.

Carpenter disclosed (col. 5, line 66), “the canon comprises an abstract template that describes a structure of the domain of information (uniquely identified)...” col. 6, line 3, “each division or part of each of the element is subsequently defined in terms of less abstract elements until resolving to a concrete element. The canonical elements are assigned attributes that define qualities of the canonical elements.”

Per claim 3:

-each action statement is linked to one or more corresponding conditional statements;

-wherein the associated tag for each action statement includes information relating to the conditional statement to which the action statement is directly linked, status information indicating a condition relating to the directly linked conditional statement under which the action statement is executed, and information relating to all linked conditional statements representing conditions under which the action statement is executed.

Carpenter disclosed (col. 29, line 41), “Relationships exist when a domain contains data that is dependent upon other data in the domain.” Col. 30, line 1, “The canonical elements may also be assigned **attributes that define certain qualities about those elements** (relating). For example, the attributes may include element types (e.g., group and result elements) and modifiers. Group

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elements are elements that contain children...” (emphasis added) Col. 30, line 11, “A Maps utility is included to create a map fro translating data from one format to another... These maps are based on the Canon for which the data conversion is needed...” Col. 3, line 33, “Building a map entails selecting each component of the input file and defining its function in terms of the Canon defined during the process of building a map. For example, group elements may have modifiers defined for them. A modifier is a **conditional statement** that further defines its function...” (emphasis added)

Per claim 4:

-the method is implemented using computer software.

Carpenter disclosed computer software at col. 10, line 51.

Per claim 6:

See limitations addressed in claim 1 above.

Additionally:

-generating a second computer source code based on each action set and the associated set of action statements.

Carpenter: Col. 39: 13, “many different file formats”

Per claim 10:

See limitaions addressed in claim 1 above.

Additionally:

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-loading a database with each action set and the associated set of action statements.

Carpenter: Col. 21: 7-56, "The Activity Plan Builder 146d is provided...Activity Plans are the objects that manage a set of tasks to perform a unit of business work...Activity Plan object itself is simply a manager and container for the tasks (database with each action set and the associated set of action statements) that get the work done. An ordered collection of tasks are constructed and assigned to the Activity Plan..."

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,199,068 B1 to Carpenter, in view of US Patent 5,742,827 to Ohkubo et al.

Per claim 5:

Carpenter failed to disclose:

-the method is implemented using COBOL.

However, Ohkubo disclosed (col. 5, line 43), "A syntax analyzing unit analyzes the program to form an interim expression which expresses the syntax structure and the data structure." Col. 6, line 55, "FIG. 9(a) shows a COBOL program that is to be converted."

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Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Carpenter, using the teachings of Ohkubo to convert a COBOL program, because Carpenter disclosed converting legacy programs, to reuse code, and COBOL programs are a type of legacy programs.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

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Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned: 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman



03/15/2007